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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,038	08/31/2001	Ann Mond Johnson		3056

34060 7590 03/23/2007
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EXAMINER

COBANOGU, DILEK B

ART UNIT	PAPER NUMBER
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3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	03/23/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/945,038
Filing Date: August 31, 2001
Appellant(s): JOHNSON ET AL.

MAILED
MAR 23 2007
GROUP 3600

Michael Haynes
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 14, 2007 appealing from the
Office action mailed May 31, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,584,445 B2	PAPAGEORGE	6-2003
5,724,379	PERKINS et al.	3-1998

(6) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papageorge (U.S. Patent No. 6,584,445 B2) in view of Perkins et al. (U.S. Patent No. 5,724,379).

A. As per claim 1, Papageorge discloses a method for providing healthcare information and treatment options for a previously diagnosed condition of a particular healthcare consumer (Papageorge; abstract and col. 7, line 60 to col. 8, line 4), said method comprising the steps of:

- i. Providing, to the particular healthcare consumer, information relating to said condition from at least one database (Papageorge; abstract),

Papageorge fails to expressly teach without involving a medical professional; providing to the particular healthcare consumer, information relating to said previously diagnosed condition from at least one database said information comprising, with respect to treating the previously diagnosed condition in other healthcare

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consumers. However, this feature is well known in the art, as evidenced by Perkins et al.

In particular, Perkins et al. discloses without involving a medical professional; providing to the particular healthcare consumer, information relating to said previously diagnosed condition from at least one database said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers (Perkins et al.; col. 2, lines 5-15).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Perkins with the motivation of getting more efficient healthcare services when comparing health-care services from different providers (Perkins et al.; col. 1, lines 56-58).

Papageorge also fails to expressly teach providing for each of plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality. However, this feature is well known in the art, as evidenced by Perkins et al.

In particular, Perkins et al. discloses providing for each of plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality (Perkins et al.; col. 2, lines 30-36 and col. 2, line 66 to col. 3, line 27).

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It would have been obvious to one having ordinary skill in the art at the time of the invention to have include the aforementioned limitation as disclosed by Perkins with motivation of ensure that the healthcare services being rendered to the patient population are made more efficient (Perkins; abstract).

- ii. Papageorge also fails to expressly teach receiving from the particular healthcare consumer, a plurality of criteria, related to selecting a desired healthcare provider to treat the previously diagnosed condition. However, this feature is well known in the art, as evidenced by Perkins et al.

In particular, Perkins et al. discloses receiving from the particular healthcare consumer, a plurality of criteria, related to selecting a desired healthcare provider to treat the previously diagnosed condition (Perkins et al.; col. 2, lines 5-15).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Perkins with the motivation of getting more efficient healthcare services when comparing health-care services from different providers (Perkins et al.; col. 1, lines 56-58).

- iii. Identifying to the healthcare consumer, treatment options (Papageorge; abstract and col. 8, lines 12-21)

Papageorge fails to expressly teach identifying treatment options for said previously diagnosed condition, said identified treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria. However, this feature is well known in the art, as evidenced by Perkins et al. In particular, Perkins et al. discloses identifying treatment options for said previously diagnosed condition, said treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria (Perkins et al.; col. 2, lines 5-15 and lines 30-36).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Perkins with the motivation of getting more efficient healthcare services when comparing health-care services from different providers (Perkins et al.; col. 1, lines 56-58).

B. As per claim 2, Papageorge discloses the method of claim 1, further comprising the step of correlating the identified treatment options with demographic data (Papageorge; col. 7, lines 27-29 and col. 7, line 65 to col. 8, line 4).

C. As per claim 3, Papageorge discloses the method of claim 1, further comprising the step of correlating the identified treatment options with the

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plurality of criteria selected and ranked by the particular healthcare consumer (Papageorge; col. 6, line 66 to col. 7, line 7).

D. As per claim 4, Papageorge discloses the method of claim 1, further comprising the step of updating said at least one database (Papageorge; col. 7, lines 17-19).

(10) Response to Argument

In the Appeal Brief filed 18 December 2006, Appellant makes the following arguments:

A) Applicant respectfully asks where any of the applied portions of the relied upon references teach:

a. "providing" "the particular healthcare consumer" "information comprising", "for each of a plurality of healthcare providers", "a measure of the healthcare provider's charges"?

b. "providing, to the particular healthcare consumer, information relating to said previously diagnosed condition from at least one database, said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality"?

B) Applicant respectfully asks:

a. how are any alleged criteria of the applied portions of the relied upon references "related to selecting a desired healthcare provider to treat the previously diagnosed condition"?

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b. where does any applied portion of any relied upon reference teach "receiving, from the particular healthcare consumer," such criteria?

C) Applicant respectfully asks any of the applied portions of the relied upon references teach:

a. "treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria"?

b. "identifying" to "the particular healthcare consumer" "treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria" ?

c. "identifying, to the particular healthcare consumer, treatment options for said previously diagnosed condition, said identified treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria"?

D) Applicant respectfully asks where the applied portion of Perkins provides a "suggestion, motivation or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references",
2. "select the teachings of (the) separate references"; or
3. "combine (those teachings) in the way that would produce the claimed" subject matter.

E) The Final Office Action presents no proof, and notably no evidence whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to", for the additional subject matter of claim 2:

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed"

subject matter.

F) Applicant respectfully asks where any of the applied portions of the relied upon references teach:

- a. that any criteria are "ranked"?
- b. that "the plurality of criteria" are "ranked by the particular healthcare

consumer"?

c. "correlating the identified treatment options with the plurality of criteria, the plurality of criteria selected and ranked by the particular healthcare consumer"?

G) The Final Office Action presents no proof, and notably no evidence whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to", for the additional subject matter of claim 3:

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed"

subject matter.

H) The Final Office Action presents no proof, and notably no evidence whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to", for the additional subject matter of claim 4:

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed"

subject matter.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

Argument A:

In response to Appellant's first argument, the Examiner respectfully submits that:

a. Perkins teaches claims records of health care experience and claims information in the course of paying claims in col. 2, line 66 to col. 3, line 27. Perkins also teaches in the figure; under computer processed step: process patient linked information to determine extent of systematic relationships of clinical complexity: "cost", utilization of procedures, indicia of quality of healthcare services rendered to patients and process systematic relationships: to compare independently of clinical complexity; "cost", utilization of procedures, indicia of quality of health care services rendered to different groups of patients by different providers. And the motivation is taught in col. 2, line 66 to col. 3, line 27: comparing healthcare services, so that provider comparisons can be used to improve the efficiency of the healthcare services. In addition, in further consideration Examiner noticed that Pappageorge teaches "The data entered by the

patient and physician users is immediately integrated and quantified by the system. Certain data is used by the system to estimate direct and indirect costs for each treatment option" in col. 7, lines 33-36.

b. Perkins teaches providing to the particular healthcare consumer a measure of the healthcare provider's charges" as explained in the section A(a) above. Perkins also teaches "by using systematic relationships of the compared criteria to the clinical complexity groups, we can compare utilization of procedures, and indicia of quality of health care services rendered to different groups of patients by different providers" in col. 2, lines 30-36.

Argument B:

In response to Appellant's second argument, the Examiner respectfully submits that:

a. how are any alleged criteria of the applied portions of the relied upon references "related to selecting a desired healthcare provider to treat the previously diagnosed condition"; Perkins teaches grouping the diseases experienced by the patients into groups that differ from each other in the clinical complexity of treating the diseases, assigning each patient to one of the groups based on clinical information or indicators available in databases for age, gender, diagnosis and utilization of selected procedures indicative of a patient's health status and disease history in col. 2, lines 5-15, Examiner respectfully submits that clinical information and indicators stated above are related to selecting a desired healthcare provider.

b. where does any applied portion of any relied upon reference teach "receiving, from the particular healthcare consumer," such criteria; Perkins teaches clinical

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information and indicators, such as age, gender, diagnoses, and preferably comorbidity and utilization of selected procedures indicative of a patient's health status and disease history in col. 2, lines 5-15. Examiner considers that the age and gender information are received from the patient (healthcare consumer) at least in the beginning and this information is readily available in the databases. In addition, in further consideration Examiner noticed that Pappageorge teaches "a patient input module for patient input of patient data concerning the patient's lifestyle and preferences" in abstract and in col. 4, lines 4-9.

Argument C:

In response to Appellant's third argument, the Examiner respectfully submits that:

a. Papageorge teaches treatment options, more specifically treatment selection and decision-making process in order to choose among different costs and post-treatment outcomes (options) in col.4, lines 10-14; Perkins teaches a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria, more specifically grouping diseases by clinical complexity, dividing the patient of population into the different groups of clinical complexity by assigning each patient to one of the groups based on clinical information or indicators available in the data bases for ages, gender, diagnoses (prioritized criteria) and comparing utilization procedures, and indicia of quality of health care services rendered to different groups of patients by different providers in col. 2, lines 5-15 and in lines 30-36.

b. Papageorge teaches identifying the particular healthcare consumer treatment options, more specifically database of the latest medical findings concerning the

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particular disease and condition in abstract and col. 4, lines 10-14, Perkins teaches comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria, more specifically grouping diseases by clinical complexity, dividing the patient of population into the different groups of clinical complexity by assigning each patient to one of the groups based on clinical information or indicators available in the data bases for ages, gender, diagnoses (prioritized criteria) and comparing utilization procedures, and indicia of quality of health care services rendered to different groups of patients by different providers in col. 2, lines 5-15 and lines 30-36

c. Papageorge teaches identifying, to the particular healthcare consumer, treatment options for said previously diagnosed condition, more specifically treatment selection and decision-making process in order to choose among different costs and post-treatment outcomes (options) in col.4, lines 10-14; Perkins teaches a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria, more specifically grouping diseases by clinical complexity, dividing the patient of population into the different groups of clinical complexity by assigning each patient to one of the groups based on clinical information or indicators available in the data bases for ages, gender, diagnoses (prioritized criteria) and comparing utilization procedures, and indicia of quality of health care services rendered to different groups of patients by different providers in col. 2, lines 5-15 and in lines 30-36.

Argument D:

In response to Appellant's forth argument, the Examiner respectfully submits that:

Perkins provides a "suggestion, motivation or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references",
2. "select the teachings of (the) separate references"; or
3. "combine (those teachings) in the way that would produce the claimed"

subject matter.

Papageorge teaches a tool designed to help patients reach the best treatment options taking into account into consideration the patient's lifestyle and personal choices, the cost and effectiveness in col. 3, line 66 to col. 4, lines 3; Perkins teaches comparing utilization of procedures, and indicia of quality of healthcare services rendered to different groups of patients by different providers, which dividing groups by clinical complexity, by assigning each patient to one of the groups based on clinical information or indicators available in the data bases for ages, gender, diagnoses (prioritized criteria). The motivation to combine Papageorge and Perkins is that healthcare services can be made more efficient by using a better way of comparing healthcare services from different providers as Perkins teaches in col. 1, lines 56-58.

The analogous art test requires that the Board show that a reference is either in the filed of the Applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. In re Oetiker, 977 F.2d 143, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. Id. ("(I)t is necessary to consider the reality of the circumstances,'-in other

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words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor."

(quoting In re Wood, 599 F.2d 1032, 1036 (C.C.P.A. 1976))). We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight. See id.; In re clay, 966 F2d 656, 659-60 (Fed. Cir. 1992).

Argument E:

In response to Appellant's fifth argument, the Examiner respectfully submits that:

Since claim 2 depends on independent claim 1 and recites the method of claim 1, the motivation to combine Papageorge and Perkins for claim 2 is the same as the motivation to combine these references for claim 1 as explained above in response to Argument D.

Argument F:

In response to Appellant's sixth argument, the Examiner respectfully submits that:

a. Papageorge teaches ranking criteria in col. 6, line 66 to col. 7, line 7; more specifically patient is asked about his/her functional status and how much it may be impaired; whether work, family, lifestyle, and/or future plans are affected; and treatment preferences, given the probable risks associated with each one.

b. Papageorge teaches "the plurality of criteria" are "ranked by the particular healthcare consumer" in col. 6, line 66 to col. 7, line 7; more specifically as explained above in section (a).

c. Papageorge teaches "correlating the identified treatment options with the plurality of criteria, the plurality of criteria selected and ranked by the particular healthcare consumer" in col. 6, line 66 to col. 7, line 7; more specifically as explained above in section (a).

Argument G:

In response to Appellant's seventh argument, the Examiner respectfully submits that: Since claim 3 depends on independent claim 1 and recites the method of claim 1, the motivation to combine Papageorge and Perkins for claim 3 is the same as the motivation to combine these references for claim 1 as explained above in response to Argument D.

Argument F:

In response to Appellant's seventh argument, the Examiner respectfully submits that: Since claim 4 depends on independent claim 1 and recites the method of claim 1, the motivation to combine Papageorge and Perkins for claim 4 is the same as the motivation to combine these references for claim 1 as explained above in response to Argument D.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Dilek B. Cobanoglu

DBC

February 8, 2007

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